Supreme Court, U. S.
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IN THE

Supreme Court of the United States

OCTOBER TERM, 1979

No. 79-1692

FAMOLARE, INC.,

Petitioner,

vs.

EDISON BROTHERS STORES, INC. AND
USM CORP.,

Respondents.

REPLY TO RESPONDENTS' BRIEF IN OPPOSITION.

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May 20, 1980

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The same Constitutional standards and statutory conditions for patentability are applicable to design and utility patents alike. Petitioner has certainly acknowledged that proposition and does not suggest to this Court that it need depart therefrom in order to correct the error of the courts below. Yet there is a gnawing awareness by almost every judge and lawyer that has focused on the issue that the attributes and manifestations of non-obvious ornamental design inventions are inherently different from those of non-obvious mechanical, electrical and chemical inventions. The question is not *whether* to apply the principles of *Graham* v. *John Deere Co.*, 383 U. S. 1 (1966), to design patents, but *how* to apply them.

The district court opinion below, almost fortuitously, provides a reference by which to evaluate the Seventh Circuit's approach to design patentability. For after it held the design patent

invalid as obvious over the asserted prior art, it held a utility patent directed to the same shoe sole design non-obvious over that very prior art, invalidating it on other grounds. The district court itself referred to that glaring incongruity ("The question may be asked . . ." A 45). And the Seventh Circuit mused over "the paradox inherent in finding the design patent obvious while finding the utility patent non-obvious" (A 11).

Petitioner submits that this "paradox" evidences an error of law resulting from the application of an improperly severe standard for design patentability, viewed both on an absolute scale and, in this unique case, by comparison with the utility patent standard. The necessary lowering of the Seventh Circuit's design standard is simply to bring it into conformance with the Constitution, section 103 and five other circuits.

CONCLUSION.

The Petition for Certiorari should be granted.[1]

Respectfully submitted,

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May 20, 1980

1. By way of clarification rather than reply, petitioner notes that Plaintiff's Trial Exhibit 586 entitled "Representative USM Soles and Edison Shoes" and included at page A 52 of the appendix to the petition contains three items not charged at trial with infringement of either Famolare patent. These are PTX 37a (Wave), PTX 42 (Rolling) and PTX 25. As explained in paragraphs 6.7 and 9.6 of the final pre-trial order, exhibits 37a and 25 would have been charged with infringement had they been made or sold after the issuance of either patent. A charge of design patent infringement relative to PTX 42 was withdrawn at trial.